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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,945	02/21/2006	Atsuki Ishida	27691.11 / Y03S017PCT-US	8307
27683 7590 07/27/2010 HAYNES AND BOONE, LLP IP Section 2323 Victory Avenue Suite 700 Dallas, TX 75219				
EXAMINER JAROENCHONWANT, BUNJOB				
ART UNIT		PAPER NUMBER		
2447				
MAIL DATE		DELIVERY MODE		
07/27/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/536,945

**Applicant(s)**

ISHIDA ET AL.

**Examiner**

BUNJOB JAROENCHONWANIT

**Art Unit**

2447

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-8, 11-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-8 and 11-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI.08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This Office Action is in response to amendment/reconsideration filed 3/29/10, the amendment/reconsideration has been considered. Claims 6-8, 11-15 are pending for examination.

***Response to Arguments***

2. Applicant's arguments have been fully considered but they are not persuasive. In the remark Applicant argues in substance that:

- a. As to claims 15, the prior art of record does not teach a relay device installed in a client device, and goes on support the argument that the DVD in Saito does not have an AV connector or relay device installed within.
- b. With respect to claims 6 and 7, Applicant argues that the prior art does not teach command conversion unit.
- c. With respect to claims 8, 11, and 12, Applicant argues that the prior art is silent on model identification section.
- d. With respect to claims 13-14, Applicant argues that the prior art of record does not teach a relay device installed in a client device.

3. In response to point a., Applicant's argument that the references fail to show certain features of Applicant's invention, it is noted that the features upon which Applicant relies (i.e., AV connector being installed in DVD) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant is reminded that no terminologies in claim 15 that suggest the client must be a home

appliance, DVD, or the like. In so far, the claimed client device could be a PC that is capable of communicating to the Internet. Saito teaches that the PC is a client in the home network, see figure 3.

4. In response to point b., Applicant argument against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Although, the previous examiner inadvertently admitting that Saito does not teach command conversion unit, the claim's language recites, "[S]erver has a command covers ion unit for converting instruction...receiver from a user." Applicant is directed to the teachings in Saito, (fig. 2, 8, ¶0033, and ¶0070), that teach a gateway unit, i.e., the server, that receives controlling command from a user over the Internet and converts the command to/from appropriate protocols.

Further, for the sake of discussion, Breh also teaches elements and features for command conversion. Applicant's reasoning to distinguish Behr's teaching from applicant command conversion is unpersuasive. Applicant should realize that the argument that directs to the preamble of the claim or the any issue that is not in the claim would not be considered. Applicant's argument expands the phrase, "appliance specific command," and goes on comparing a device specific command with markup language conversion in Breh and concludes that they are not the same feature. Therefore, Breh does not teach the same. Applicant is kindly reminded that the claim language, in so far, merely states, "[S]aid command being in said predetermined specific to the network-enabled home appliance." In the Office's view point,

predetermined format could have been any format that differs from the other and required format conversion.

5. In response to point c., Saito-Breh teaches home network appliance that is capable of being controlled from a user over the Internet. The system taught is capable of identifying network or home network devices. Inherently, it already includes a mechanism, software, or hardware for identifying network device indication. The mere fact that the claim recites model indication from determining specific model type address or identifier would have been obvious variation of application's choice. Since Saito is capable of identifying different types of devices and specific device command conversion, identifying the model for command conversion does not produce any unpredictable result.

6. In response to Applicant's arguments, the recitation "[R]elay device installed in a client device which is communicable with the relay device but cannot independently connect to the Internet" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand-alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

#### ***Response to Amendment***

7. The amendment to overcome the rejection 35 U.S.C. §112 ¶2 by adding, an instruction received from a user, does not change scope of the claims.

8. Saito and Breh were cited as prior arts for claims' rejections. The citations applicable are hereby incorporated by reference.
9. The previous grounds of rejections are maintained. Instead of reiteration, all grounds, of previous rejection, are hereby incorporated by reference.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BUNJOB JAROENCHONWANIT whose telephone number is (571)272-3913. The examiner can normally be reached on 6:00-14:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joon H. Hwang can be reached on (571) 272-4036. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BUNJOB JAROENCHONWANIT/  
Primary Examiner  
Art Unit 2447

/bj/  
7/20/2010